UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/579,846	05/25/2000	Richard Wisniewski	17882-733	8512

7590 08/30/2004

NICHOLAS MESITI, ESQ
HESLIN, ROTHENBERG, FARLEY & MESITI P.C.
5 COLUMBIA CIRCLE
ALBANY, NY 12203-5160

EXAMINER	
FORD, JOHN K	
ART UNIT	PAPER NUMBER
3753	

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/579,846
Filing Date: May 20, 2000
Appellant(s): WISNIEWSKI, RICHARD

Victor A. Cardona
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 23, 2004.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

This appeal involves claims 2, 3, 6-9 and 18-21.

Claims 1, 4, 5 and 10-17 have been canceled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

No amendment after final has been filed.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

The Examiner notes that Appellant has not presented as issues the rejection of claims 3 and 6-8 over the prior art as applied to claims 2, 9 and 18-21 and further in view of Baldus or of claims 6-8 over the same prior art and further in view of Schmidt DE 3047784 or the Quan et al. journal article. Given that all of these particular

dependent claims, directly or indirectly, depend from claim 18 and that none are deemed patentable over claim 18 (i.e. claims 2, 3, 6-9 and 18 stand or fall together as indicated in the Brief), the omission of these issues clearly simplifies the appeal and, therefore, approved. The Board will consider the rejection of claim 18.

(7) Grouping of Claims

The Examiner notes at the onset that claims 2-3 and 6-9 all stand and fall together with claim 18, based on the parenthetical remarks found on page 5 of the Brief. Thus, even though claims 7 and 8 continue to depend from cancelled claims 4 and 5, as construed by Appellant, they are to be treated as depending from claim 18. The rejections made in the Examiner's final office action were fashioned on this assumption.

The Examiner also notes that while claims 19-21, are allegedly separately patentable, only claim 20 has a separately identified reason supporting that separate alleged patentability (namely the claim limitation that there by a " motor driving a linkage").

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because no reasons are presented for why claims 19 and 21 are separately patentable from the arguments made with respect to claim 18.

The Board should note that claims 19 and 21 are broader in scope than claim 18, in that no "rolling" is required, only "moving".

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

U.S. Patents

4,178,776	BALDUS et al.	12/1979
5,999,701	SCHMIDT	12/1999

Foriegn Patents

JP 63-296,831	NABEYA (I)	12/1988
JP 2-187,138	NABEYA (II)	7/1990
JP 2-261,371	UMETSU	10/1990
DE 3047784	SCHEIWE et al.	7/1982

Non-Patent Literature

« Large-Scale Freezing and Thawing of Biopharmaceutical Drug Product", Wisniewski & Wu (GENENTECH). Proceedings of the International Congress, February 1992 pp. 132-140.

"Effects of Vibration on Ice Contact Melting Within Rectangular Enclosures," Quan, Zhang and Faghri. Transactions of the ASME Vol: 120, May 1998, pp. 518-520.

(10) Grounds of Rejection

The following six ground(s) of rejection are applicable to the appealed claims:

Claims 2, 3, 6-9 and 18-21 are rejected under 35 U.S.C. 112, first paragraph. This rejection is set forth in a prior Office Action, Paper 18, pages 2-3.

Claims 2, 9 and 18-21 are rejected under 35 U.S.C. 103 (a). This rejection is set forth in a prior Office Action, Paper 18, pages 4-7.

Claims 3 and 6-8 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, Paper 18, page 7.

Claims 6-8 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, Paper 18, pages 7-8.

Claims 6-8 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, Paper 18,page 8.

Claims 6-8 are rejected under 35 U.S.C. 103(a). This rejection is set forth in a prior Office Action, Paper 18, pages 8-9.

(11) Response to Argument

1. 35 U.S.C. 112, first paragraph rejection.

The statute requires applicant to have been in possession at the time of filing of the now claimed subject matter. The claims have been amended to state that the "container" (see Figure 1), not the "wheeled container" as argued by counsel, rolls or moves (again, not the "wheeled container") from a first position to a second position along and in contact with a surface (and vice versa). It is submitted, notwithstanding

counsel's remarks to the contrary that a container is a container (i.e. as any standard dictionary; a receptacle for holding or carrying material).

Independent claims 18 states, in essence, that the container itself rolls along the surface (e.g. the way a can of soda would roll across the floor if dropped in the Examiner's interpretation of this limitation).

Claims 19-21 don't even claim "rolling", but, rather, that the container itself moves along and in contact with a surface.

The container in elected Figure 1 itself translates back and forth, back and forth, horizontally, by the action of driver 104 (as shown by the schematic arrows above driver 104).

Apparently, some sort of vertical motion, presently unclaimed, is induced by driver 106. The only thing that "rolls" in elected Figure 1 are the rollers or wheels on the base structures that nearly vertical canted legs supporting the container are attached to. The container does not roll; it translates back and forth by the action of driver 104. In an effort to claim the device as broadly as possible, counsel, it is submitted has overstepped the bounds of the underlying disclosure. In support of counsel's interpretation, at the bottom of page 6 of the Brief, counsel offers the colloquialism of a car "rolling" from one place to another. Using the same colloquial expression the Examiner believes that most people, when they here that a car "rolled", think of type of serious accident in which the vehicle " rolls-over" on its side or of. Most cars don't "roll" from place to place – they are driven from place to place. Nonetheless the analogy is misplaced because claims 18-21 require the container itself (not a wheeled container) to

move or roll along and in contact with a surface between two discrete positions. It is submitted that no amount of argument in the Brief will change the fact that the container (i.e. the receptacle for holding or carrying material) is not in contact with the aforementioned surface. Only the wheels or rollers that support the container relative to the aforementioned surface in Figure 1 are in contact with that surface. It is noted that counsel's arguments on page 7 of the Brief end with an admission that "wheels or other means" would be necessary to have the rolling recitation make sense. Unfortunately, that is not what the claim says. It is also noted that, regarding the dictionary definition submitted with the Brief, aside from skipping over the first definition of the verb "roll" (to turn over and over on a surface), counsel has failed to explain how the container itself can roll along and be in contact with a surface and at the same time have "wheels or other means" separating the container from the surface. The Examiner therefore respectfully submits that the 35 U.S.C. 112, first paragraph, rejection should be sustained by the Board of Appeals.

2. W+W Article in view of JP 63-246,831.

Part of the reason for making the 35 USC 112, first paragraph, rejection above was because the Examiner doesn't understand the arguments made here. The rejection is extremely simple. The W+W article, authored in part by Appellant here when he was an employee of Genentech, clearly states: " Another option for providing agitation during thawing is to shake or move the entire tank on a mechanical shaker platform."

Counsel is correct when he states that the container of W+W when placed by one of ordinary skill atop the shaker table upper surface (shown in Fig 1 of JP 63-296831) would be mounted stationary relative to that upper shaken surface (while it forms no part of the rejection here see DE 3047784, Figure 5, that illustrates what counsel is asserting) however as it was shaken back and forth it would roll on rollers 19 back and forth along with the top of the shaker table. The distance the container would roll back and forth on rollers 19 depends on the eccentricity of pin 11 relative to the center of flywheel 8. Pure back and forth motion of the upper portion of the shaker between two extremes occurs when the plate 21 is in the position shown in Figure 3 and 4 (i.e. retracted away from the eccentric). When plate 21 is in the forward-most position (and bearing 10 is captured in cut-out 23) as shown in Figure 5 the upper portion of the shaker undergoes pure rotational motion (i.e. coordinated back and forth motion in two perpendicular directions simultaneously), which would also meet the claims. The '831 reference is most easily understood, however, with 21 in its retracted position (as shown in Figure 3 and 4) and the Examiner relies on that particular embodiment for ease of understanding. The entire tank of W+W, when placed on the shaker table of JP 63-296831 would be moved or rolled (via rollers 19) between a first and second position (determined by the eccentricity of pin 11) and back again repetitively (until motor 2 was turned off), along a surface 20 as specified in the claims. The Examiner admits that there is support structure between rollers 19 and the W+W container when placed on the surface of the shaker table but that is equally true in Appellant's disclosure (where wheels and legs and some sort of frame are clearly shown in elected Figure 1). It is also

true that rollers 19 roll on two flanges 20 attached to a stationary base member 1. Since a "surface" is the outer or topmost boundary of an object, the "surface" that the rollers 19 roll on is defined by the topmost surface of flanges 20, in particular the flat portion that rollers 19 contact and the top most surface of base member 1 in every region except where flanges 20 are shown. Since there is no requirement in any claim that the rolling surface be flat (in fact, there couldn't be given applicant's 6A embodiment and assertions that claim 18 is generic to all species), the rolling surface, as defined by the Examiner above, constitutes a single surface to roll on even though it is formed of these separate elements (base 1 and two flanges 20) attached together to form a unitary (and stationary) rolling surface. Also, the W+W article does not say to put the wheeled container on a mechanical shaker platform, it states that it is another option "to shake or move the entire tank on a mechanical shaker platform." The reference here DE '784 is only to show how samples are placed on a shaker table and it forms no part of the rejection except to demonstrate conventional knowledge.

3. W+W Article in view of JP 2-187,138.

Appellant attacks JP '138 alleging that the container of W+W when placed on the shaker table of JP'138 " to shake or move the entire tank on a mechanical shaker platform" (as disclosed on page 134, col. 1 third full paragraph of the W+W article) would not move or roll in contact with a surface. Appellant states, in the Brief at page 12, line 18:

"Instead, the platform [of JP '138] itself is alleged to roll as opposed to a container rolling." It is submitted that in view of such an argument, the 35 U.S.C. 112, first paragraph, rejection set forth above is material. In contrast to the arguments made to the 35 U.S.C. 112, first paragraph rejection, where counsel admitted that the container had to roll on (unclaimed) wheels or rollers in the same colloquial way that a car had to roll on it wheels, counsel now, inconsistently, in the Examiner's view, argues that the container itself has to roll in order to differentiate the purported invention from prior art that fairly discloses a shaker table surface 20 with rollers 7 which supports and permit the container placed on it (W+W article) to translate back and forth while the rollers 7 supporting the container roll back and forth on tracks 8 attached to base 1. This is precisely what the unclaimed wheels or rollers in Appellant's elected Figure 1 do with respect to "rolling" container 102, counsel's remarks to the contrary notwithstanding.

As admitted by counsel at the bottom of page 12 of the Brief, any container when placed on surface 20 would remain stationary relative to that surface 20 (by virtue of among other constraints supports 22), as is submitted to be conventional knowledge in the shaker table art. Because surface 20 is translated or moved back and forth on rollers 7 the container resting on it (if the shaking is not extreme) or fixedly mounted to it undergoes the same motion, counsel's remarks to the contrary notwithstanding. Again the "surface" that the container "rolls on" is defined by the each of surfaces of tracks 8 that support rollers 7 and the upper surfaces of any disclosed intervening support structure that is not covered by tracks 8 including base plate 1. Together the aforementioned surfaces as explicitly defined above constitute a single surface that all

four rollers 7 roll upon when translating the container of W+W back and forth along with surface 20 (i.e. when the container is mounted to translate back and forth with surface 20).

4. W+W Article in view of JP 2-261,371

When JP'371 has lever set in the " B" position the table 19 undergoes pure translation motion back and forth in the "X" direction on rollers 21, which roll along the surface of support bars 17. A motor 5 drives the system through an eccentric pin 12 and flywheel 8. When the container of W+W is placed on surface 19 (and remains stationary to surface 19 as is conventional in the shaker table art) it undergoes translation in the X-direction back and forth between two positions (defined by the eccentricity of pin 12). The notion advanced by counsel that the container would be thrown off the platform is not consistent with the level of ordinary skill that is required to practice the shaker table art. No one of ordinary skill in this art, it is submitted, would place a container on high amplitude, high frequency shaker table without appropriate fixing means to anchor the container to the moving surface (where gravity alone was not sufficient to maintain static frictional contact). On some low frequency, low amplitude shaker static friction between the lower surface of the container and the upper, moving, surface of the shaker table can be enough, but for more violent agitation it is submitted to be conventional to employ anchoring structure of some sort. To do what counsel alleges would not only be dangerous to people around the shaker table but would likely involve damage and loss to the container and/or its contents. Again, DE 3047784, not relied upon here except to

show conventional knowledge in this field shows the shaken samples mounted stationary relative to the top plate of the shaker table, thereby moving with it.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John K. Ford
Primary Examiner

John Ford
August 5, 2004

Conferees
Dave Scherbel
Leonard Leo

David A. Scherbel
Supervisory Patent Examiner
Group 3700

NICHOLAS MESITI, ESQ
HESLIN, ROTHENBERG, FARLEY & MESITI P.C.
5 COLUMBIA CIRCLE
ALBANY, NY 12203-5160